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EXAMINER

MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/585,134

Applicant(s)

ALBERTSON ET AL.

Examiner

Katherine W Mitchell

Art Unit

3677

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-12, 14-48 is/are pending in the application.
- 4a) Of the above claim(s) 12, 16, 18, 19, 24-34, 40, 42 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 10, 11, 14, 15, 17, 20-23, 35-39, 41 and 44-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/26/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. The Terminal Disclaimer filed 6/14/04 has been approved and entered.

### ***Election/Restrictions***

2. Applicant's election without traverse of Claims 14 and 15 in the reply filed on Sept 21, 2004 is acknowledged. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Claims 12, 16, 18, 19, 24-34, 40, 42, and 43, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/21/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

4. Examiner notes that applicant stated that he was electing claims 14 and 15 only. However, examiner believes applicant intended to also elect the generic claims and is examining Claims 10, 11, 17, 20-23, 35-39, 41, and 44-48 also.

### ***Claim Objections***

5. Claim 17 is objected to because of the following informalities: Applicant claims a "separate" physical property. This is unclear – separate from what? Examiner assumes

Art Unit: 3677

this means a physical property different than the physical property indicated by the color of claim 14. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 10-11, 35,41, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickson USP 5511917 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dickson in view of Schwartz USP 5181439.

Re claims 10 and 35: Dickson teaches a joint (Fig 3) comprising 1<sup>st</sup> and 2<sup>nd</sup> surfaces (horizontal and vertical boards, unlabeled). Dickson further teaches a fastener securing the first and 2<sup>nd</sup> surfaces together, said fastener having an exposed identifying indicia portion, said indicia preselected to define at least one fastener physical property (length or gauge, Dickson col 2 lines 7-37), on the exposed portion. Dickson teaches in col 1 lines 60-67 that graphic indicia on the head of a fastener allow building inspectors to tell quickly if a fastener meets the building code requirements by just looking at the fastener head, thus inevitably the surfaces are at least capable of being subject to regulations requiring specific physical properties for fasteners used to join said surfaces. Col 5 lines 25-40 teach that the indicia may be a color, and col 1 lines 39-41 also teach that it is well-known to preselect a color to correlate to a physical property, such as diameter, of a fastener. Examiner notes that in an apparatus claim, as long as the

Art Unit: 3677

structure is taught, equivalent structures are capable of performing the same functions. The method of forming the device, i.e., motivation to select a particular color or indicia, is not germane to the issue of patentability of the device itself.

Re claim 11: Applicant is claiming a structure, and the method of using the device is not germane to the issue of patentability of the device itself as long as the cited structure is capable of meeting that limitation. Any structure is capable of being subject to the Uniform Building Code.

Re claim 41: Adding a symbol to the fastener to connote a separate physical property is taught by Dickson in col 4 lines 59-66, which teaches the use of multiple graphic symbols to connote a separate physical property – gauge and length.

Re claim 44: The fastener color is capable of being selected to specify application properties of the fastener. Applicant is claiming the structure, not the method of use.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20-23 and 36-39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Schwartz USP 5181439.

Re claims 20-23 and 36-39: As discussed above, Dickson <sup>has</sup> ~~have~~ been shown to <sup>WMS</sup> teach all the elements except that the color of the exposed portion is visible from a

Art Unit: 3677

specific distance away, including 10,15,18, and 20 feet. Dickson teaches in col 1 lines 60-67 that graphic indicia on the head of a fastener allow building inspectors to tell quickly if a fastener meets the building code requirements by just looking at the fastener head, but does not specify a distance.

Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Schwartz specifically teaches the color/property correlation for workers to use in col 2 lines 35-48, and col 3 line 17 emphasizes that with this marking, a user can tell "at a glance" the indicated property. Since the structure is the same (entire head is colored) as that of applicant, inevitably the visibility would be the same. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Schwartz before him at the time the invention was made, to modify Dickson as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification "at a glance". One would have been motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in col 1 lines 30-62, col 3 lines 53-col 4 line 3, and col 5 lines 51-64, which emphasize that the coloration be "readily seen" when the fastener is in place. Noting especially that col 5 lines 61-64 prefer coloring the top end, all sides, and the bottom of a nut, since merely one colored end would suffice for identification upon close inspection, coloring all sides obviously provides the advantage of more recognizability of the color code at greater distances.

Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at at least 10, 15, 18 and/or 20 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of at least 10, 15, 18 and/or 20 feet when the shaft is inserted into a surface since it meets the same physical structure.

10. Claims 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Campbell USP 4894963.

Re claim 14: Dickson teaches a fastener (Nail, Fig 3) and connector system (horizontal and vertical boards, unlabeled) comprising a connector (boards) capable of being subject to regulations requiring specific physical properties for fasteners. Dickson further teaches a fastener securing the first and 2<sup>nd</sup> surfaces together, said fastener having an exposed identifying indicia portion, said indicia preselected to define at least one fastener physical property (length or gauge, Dickson col 2 lines 7-37), on the exposed portion. Dickson teaches in col 1 lines 60-67 that graphic indicia on the head of a fastener allow building inspectors to tell quickly if a fastener meets the building code requirements by just looking at the fastener head, thus inevitably the surfaces are at least capable of being subject to regulations requiring specific physical properties for fasteners used to join said surfaces. However, Dickson does not require matching indicia on the connector and the fastener.

Campbell teaches a building kit comprising a fastener and connector system (Fig 3, mating at 29) comprising a connector (14 has surface 28 and 16 has surface 28) capable of being subject to regulations requiring specific physical properties, and a

Art Unit: 3677

fastener (interconnecting member 20) securing 1<sup>st</sup> and 2<sup>nd</sup> surfaces together, the fastener having a colored section exposed to view. Notice that Fig 1 clearly shows the joints with the color coded sections exposed to easy viewing. Further, Campbell teaches colors on the connector and also on the fastener. If the color on the fastener and connector match, then the connector can mate with the fastener, per col 4 lines 17-63. Col 4 lines 17-57 teach that separate colors are used to correlate separate connections, thus teaching that colors are selected to define specific physical properties.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Dickson and Campbell before him at the time the invention was made, to modify Dickson as taught by Campbell to include using indicia including colors to on both the fastener and the connector to ensure that a connector used the proper fastener, in order to ensure that connectors are used with their proper fasteners without needing to carefully verify each part, as discussed by Campbell in col 1 line 59 – col 2 line 65. Including matching the indicia colors of the connectors to the fasteners to improve visibility, in order to obtain identification and mating “at a glance”, without having to remember any key or special correlation, as matching colors are easily mated together would help reduce the time and skill needed to assemble connectors and fasteners.

Further Re claim 15: Matching color indicia on the connector and fastener are taught by Campbell in col 4 line 17-31.



Art Unit: 3677

Further Re claim 17: Adding a symbol to the fastener to connote a separate physical property is taught by Dickson in col 4 lines 59-66, which teaches the use of multiple graphic symbols to connote a separate physical property – gauge and length.

11. Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson USP 5511917 in view of Campbell USP 4894963 as applied above and further in view of Schwartz USP 5181439.

Re claims 45-48: As discussed above, Dickson in view of Campbell teach all the elements except that the color of the exposed portion is visible from a specific distance away, including 10,15,18, and 20 feet. Dickson teaches in col 1 lines 60-67 that graphic indicia on the head of a fastener allow building inspectors to tell quickly if a fastener meets the building code requirements by just looking at the fastener head, but does not specify a distance.

Schwartz teaches in col 4 lines 4-25 that a fastener head may have all of at least the top surface of the fastener color-coded. Schwartz specifically teaches the color/property correlation for workers to use in col 2 lines 35-48, and col 3 line 17 emphasizes that with this marking, a user can tell “at a glance” the indicated property. Since the structure is the same (entire head is colored) as that of applicant, inevitably the visibility would be the same. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of modified Dickson in view of Campbell and Schwartz before him at the time the invention was made, to modify Dickson in view of Campbell as taught by Schwartz to include coloring the tops of the fasteners to improve visibility, in order to obtain identification “at a glance”. One would have been

Art Unit: 3677

motivated to make such a combination because easily identifiable markings leading to faster and more accurate use of fasteners would have been obtained, as taught/suggested by Schwartz in col 1 lines 30-62, col 3 lines 53-col 4 line 3, and col 5 lines 51-64, which emphasize that the coloration be "readily seen" when the fastener is in place. Noting especially that col 5 lines 61-64 prefer coloring the top end, all sides, and the bottom of a nut, since merely one colored end would suffice for identification upon close inspection, coloring all sides provides the advantage of more recognizability of the color code at greater distances.

Also, examiner notes that since the colored top is the property allowing applicant's fastener to be recognizable at at least 10 and/or 18 feet, any colored top would inevitably be recognizable by a person of normal vision from a distance of 18 feet when the shaft is inserted into a surface since it meets the same physical structure.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Response to Arguments***

13. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

Art Unit: 3677

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwm  
12/2/2004

A handwritten signature in cursive script, appearing to read "Katherine Mitchell".